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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MATZEK, MATTHEW D

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,769

Applicant(s)

ZAFIROGLU, DIMITRI PETER

Examiner

Matthew D. Matzek

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 35-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 51-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/17/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-34 and 51-55, drawn to a composite, classified in class 442, subclass 159.
- II. Claims 35-50, drawn to a method of making a composite, classified in class 156, subclass various.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the fibers of the fibrous face layer could be embedded into a composite comprising the face layer and adhesive layer rather than having them be a part of the face layer prior to being embedded. This constitutes a materially different process.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with H. T. Than on 3/7/2005 a provisional election was made without traverse to prosecute the invention of a composite, claims 1-34 and 51-55.

Affirmation of this election must be made by applicant in replying to this Office action. Claims

35-50 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. It is unclear to Examiner what is meant by “the bottom surface has been altered to increase the surface area” because there is no description as to how the bottom surface has been altered or how the altered surface is different than an unaltered surface.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-5, 8-10, 16-18, 21-23, 26-27, 29, and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Justesen et al. (US Patent 5,902,663).
7. Justesen et al. disclose a low-stretch and dimensionally stable floor covering comprising a polymer pile material (fibrous face layer) retained to a polymeric backing material (adhesive layer), which is retained to a secondary backing material (secondary backing layer), which may be woven or nonwoven, with a polymeric adhesive and the method of making said material

(Abstract and col. 2, lines 60-65). The invention of Justesen is silent as to the nature of the pile fabric used, but Examiner takes the position that pile fabric includes reversed pile fabric. The applied patent teaches the use of needled fibers along with stitch-bonding of stitches and loops of shrinkable yarns (Abstract, col. 9, lines 11-13 and col. 14, lines 8-10). The adhesive layer is activated with the application of heat and pressure to anchor the legs (Abstract). Figure 4 shows the top surface with a plurality of downwardly facing fiber loops and the bottom surface comprising a plurality of free fiber ends. The primary backing is adhesive in nature (Abstract). In one preferred embodiment the fibrous face layer comprises a spun-bonded, non-woven layer with a plurality of free fiber ends (Fig. 2 and col. 12, lines 2-5). Example 2.1 has a spun yarn fabric facing. The applied patent discloses that embossing may be used to improve the visual appearance of the floor material (col. 13, lines 42-45).

Claim Rejections - 35 USC § 102/103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 51, 52, and 54-55 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Justesen et al. The invention of Justesen et al. has been previously disclosed.

9. Claims 51, 52, and 54-55 are rejected as the presence of process limitations on product claims, in which product does not otherwise patentably distinguish over prior art, cannot impart

patentability to the product. *In re Stephens*, 145 USPQ 656.

10. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to Applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292.

Claim Rejections - 35 USC § 103

11. Claims 2-3, 6-7, 11, 12, 15, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Justesen et al.

12. Justesen et al. disclose the claimed invention except for the instantly claimed needling density, loop frequency, and basis weights of the face layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the article of Justesen et al. with the instantly claimed needling density, loop frequency, and basis weights of the face layer, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

13. It would have been obvious to one of ordinary skill in the art to have used pattern bonding in the invention of Justesen et al. The skilled artisan would have been motivated by the desire to use less adhesive, which would impart the applied invention with cheaper production costs due to less material being used and a lighter overall weight.

14. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Justesen et al. in view of Mizutani et al. (US PGPub 2002/0028624). As previously disclosed Justesen et al. teach a low-stretch and dimensionally stable floor covering comprising a polymer pile material

retained to a polymeric backing material, which is retained to a secondary backing material with a polymeric adhesive and the method of making said material, but is silent as to the use of a heat-shrinkable film (Abstract).

15. Mizutani et al. teach an absorbent article including a liquid permeable surface layer, a backing sheet, and an absorbent layer interposed between the surface layer and the backing sheet (Abstract). The surface layer includes a porous film that may be a heat-shrinkable synthetic film (para. 14).

16. It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the article of Justesen et al. with the heat shrinkable synthetic film. The skilled artisan would have been motivated by the desire to align the fibers, thereby increasing the hand of the Justesen et al. article through the shrinking of the polymeric layer upon which they are adhered.

17. Claims 24-25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Justesen et al. in view of Zafiroglu (US Patent 5,879,779). The invention of Justesen et al. has been previously disclosed, but is silent as to the use of spunlaced fibers in the fabric facing.

18. Zafiroglu discloses an improved stitchbonded nonwoven fabric having repeating patterns of stitches in a fibrous layer (Abstract). The stitchbonded fabric comprises a fabric facing and adhesive coating (claim 1). In examples 1-3 a spunlace nonwoven fabric is used as the article's fabric facing.

19. One of ordinary skill at the time of the invention would have found it obvious to have made the facing of Justesen's article with a spunlaced fabric. The skilled artisan would have been motivated by the desire to create a fabric that can be stretched, shrunken, and/or heat set

(Abstract '779).

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

20. Claims 1, 4-5, 8-9, 16-27, 29-31, and 33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al (US Patent 6,503,595).

21. Kim et al. teach a carpet and its method of manufacture. The said carpet includes a primary backing having tufted pile fibers (fibrous face layer), which possesses a plurality of free fiber ends, protruding from a top surface and a secondary backing with a polymeric adhesive layer in between (Abstract). The fibers of the applied invention may be stitched, needle-punched, or spunlaced (col. 2, lines 7-8, lines 38-42, and lines 4-6). The face layer may be either woven or non-woven (col. 1, lines 45-50). The primary backing comprises polypropylene (col. 6, lines 6-11). The adhesive backing layer is activated through the application of heat and pressure (col. 2, lines 55-58). As the article meets the chemical and physical limitations set forth in claim 1 it is therefore capable of being embossed.

Claim Rejections - 35 USC § 102/103

22. Claims 51-55 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kim et al. The invention of Kim et al. has been previously disclosed.

23. Claims 51-55 are rejected as the presence of process limitations on product claims, in which product does not otherwise patentably distinguish over prior art, cannot impart patentability to the product. *In re Stephens*, 145 USPQ 656.

24. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to Applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292.

Claim Rejections - 35 USC § 103

25. Claims 2-3, 6-7, 10, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al.

26. Kim et al. disclose the claimed invention except for the instantly claimed needling density, loop frequency, and basis weights of the face layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the article of Kim et al. with the instantly claimed needling density, loop frequency, and basis weights of the face layer, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

27. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et

al. in view of Mizutani et al. (US PGPub 2002/0028624). The article of Kim has been previously disclosed, but but is silent as to the use of a heat-shrinkable film.

28. Mizutani et al. teach an absorbent article including a liquid permeable surface layer, a backing sheet, and an absorbent layer interposed between the surface layer and the backing sheet (Abstract). The surface layer includes a porous film that may be a heat-shrinkable synthetic film (para. 14).

29. It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the article of Kim et al. with the heat shrinkable synthetic film. The skilled artisan would have been motivated by the desire to align the fibers, thereby increasing the hand of the Kim et al. article through the shrinking of the polymeric layer upon which they are adhered.

Claim Rejections - 35 USC § 102

30. Claims 1, 4-5, 8, 16-20, 26-27, 30, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Fink (US Patent 6,051,300).

31. The Fink patent discloses a carpet and process of manufacturing said carpet (Abstract). The carpet includes a primary backing (fibrous face layer) having tufted pile of fibers protruding from a top surface and optionally a second backing with an adhesive polymeric layer in between (Abstract). Fink teaches the use of needle-punching the face fiber into the primary backing (col. 1, lines 25-30). The primary backing may include any synthetic resin woven or non-woven fabric, including spun staple fibers, a film or web (col. 1, lines 52-59, and col. 8, lines 18-20). The use of the hot-melt adhesive layer allows sufficient wetting of the tuft stitches to prevent pull-out, pilling, and fuzzing (col. 2, lines 62-65). As the article meets the chemical and physical set forth in claim 1 it is therefore capable of being embossed. The carpet of the present

disclosure is prepared by feeding a primary carpet backing into a conventional tufting machine. During the tufting process, carpet face yarn is also fed into the tufting machine wherein hundreds of individual tufting needles may be employed to stitch through the primary carpet backing thus forming a continuous web of face fiber tufted through the primary backing (col. 11, line 65-col. 12, line 49).

Claim Rejections - 35 USC § 102/103

32. Claims 51-55 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fink. The invention of Fink has been previously disclosed.

33. Claims 51-55 is rejected as the presence of process limitations on product claims, in which product does not otherwise patentably distinguish over prior art, cannot impart patentability to the product. *In re Stephens*, 145 USPQ 656.

34. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to Applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292.

Claim Rejections - 35 USC § 103

35. Claims 2-3, 6-7, 28-29, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fink.

36. Fink discloses the claimed invention except for the instantly claimed needling density, loop frequency, and basis weights of the face layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the article of Fink with

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the instantly claimed needling density, loop frequency, and basis weights of the face layer, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

37. Claim 9 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Fink in view of Murata et al. (US Patent 4,576,840). As previously stated, the Fink patent discloses a carpet and process of manufacturing said carpet (Abstract). The carpet includes a primary backing having tufted pile of fibers protruding from a top surface and optionally a second backing with an adhesive polymeric layer in between (Abstract).

38. Murata et al. disclose a composition comprising pile fibers that include shrinkable fibers that exhibit greatly improved appearance, hand and draping property (Abstract). As the fibers are shrunk the fabric undergoes a subsequent polishing treatment on its surface resulting in an attractive appearance and which is pliable with a soft feel and highly drapable (col. 1, lines 57-60).

39. It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the invention of Fink with the shrinkable fibers of Murata et al. The skilled artisan would have been motivated by the desire to improve the aesthetics and hand of the final carpet through the polishing treatment on the surface of the article that occurs when the fibers are shrunken.

40. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fink in view of Zafiroglu (US Patent 5,879,779). The invention of Fink et al. has been previously disclosed, but is silent as to the use of spunlaced fibers in the fabric facing.

41. Zafiroglu discloses an improved stitchbonded nonwoven fabric having repeating patterns of stitches in a fibrous layer (Abstract). The stitchbonded fabric comprises a fabric facing and adhesive coating (claim 1). In examples 1-3 a spunlace nonwoven fabric is used as the article's fabric facing.

42. One of ordinary skill at the time of the invention would have found it obvious to have made the facing of Fink's article with a spunlaced fabric. The skilled artisan would have been motivated by the desire to create a fabric that can be stretched, shrunken, and/or heat set (Abstract '779).

Claim Rejections - 35 USC § 102

43. Claims 1, 19, 20-23, and 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Sidles (US Patent 4,888,228).

44. Sidles discloses a composite laminate formed from plies of substrate which include fibers extending generally normal to the plane of the substrate (Abstract). An organic binder is cured between said plies to form the composite (Abstract). The method of making the laminates comprises applying uncured binder to the tufted substrate to form a ply and applying heat and pressure to transform the binder to a matrix, which substantially saturates the plies (Abstract). The substrate can be composed of a high tensile strength material. While it is preferable to use a woven material, it is anticipated that the material can include knit and non-woven materials (col. 3, lines 5-10). Collectively the tufts will form a cut pile (col. 2, lines 25-30). The applied patent also teaches the use of an additional backing (col. 5, lines 35-38). As the article meets the chemical and physical set forth in claim 1 it is therefore capable of being embossed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Matzek whose telephone number is (571) 272-2423. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mdm

